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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,704	04/27/2000	Michael D. Zoeckler	R029 1056 (7137-US)	2557

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC  
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P.O. BOX 7037  
ATLANTA, GA 30357-0037

EXAMINER
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HARMON, CHRISTOPHER R

ART UNIT	PAPER NUMBER
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3721

MAIL DATE	DELIVERY MODE
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11/08/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/559,704

Applicant(s)

ZOECKLER, MICHAEL D.

Examiner

Christopher R. Harmon

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15,25-33 and 40-76 is/are pending in the application.
- 4a) Of the above claim(s) 40-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-7,9-15 and 25-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/20/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 40-76 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The newly submitted processes are distinct. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have materially different modes of operation e.g. attaching reinforcing ribbon(s) not overlying any longitudinal fold lines. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40-76 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-7, 9-15, and 25-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

Art Unit: 3721

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation regarding the positioning and adherence of the reinforcing ribbon ie. "but not beyond" a selected or longitudinally extending panel portion of the web (claims 1 and 25, etc.) is considered new matter not disclosed in the specification or drawings. Note that the "panel portion" was previously argued (Appeal Brief of 8/3/06) and found by the Board of Patent Appeals (Decision of 5/30/07) to define "portions to become panels in the final construction". "a selected panel portion" and "a longitudinally extending panel portion" are both singular limitations. Applicant clearly shows ribbons being positioned and adhered to multiple adjacent "panel portions" thereby positioning the ribbons extending beyond the boundaries of a single "panel portion" (defined by fold lines, etc.) and subsequent cutting of both layers.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7, 9-15, and 25-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, see above.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-6, 11-13, 25, 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Claff (US 2,008,608).

Claff discloses a method for forming carton blanks comprising advancing a continuous web of non-corrugated paperboard 1 along a path; progressively applying/laminating, with an adhesive, a plurality of ribbons of reinforcing material 2 with a width less than the paperboard substantially overlying substantially all of selected panel portions 3 (ie. portions to become panels in the final construction as interpreted by the Board of Patent Appeals); the paperboard is then scored and cut into individual carton blanks and then are formed into cartons for receiving articles (see figures 1-2 and 6-7). Reinforcing strips 2 are progressively folded/sealed/adhered to opposed edge portions of the paperboard web 1; see figure 6.

Regarding claims 6 and 33, Claff teaches the possibility of further layer 14 to be added atop first and second reinforcing strips 2; see page 2, left column, lines 38+.

Regarding claims 12-13, note fold line 7 of the bottom panel is not covered and edge of the ribbons 2 are considered adjacent fold lines 6; see figure 1.

Regarding claims 30-32, note that the reinforcing strips are applied within the corresponding longitudinally extending panel portions (folded around outer edge to be positioned within) and within intermediate panel portion 8 (within the boundaries 7 defining panel portion 8); see figures 1-2.

7. Claims 1-7 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Walsh (US 5,108,355).

Walsh discloses advancing a paperboard web in order to produce a carton made from paperboard with a width and panel portions 10 that are substantially covered and progressively adhered with ribbon of paperboard reinforcing material 60; as shown in figures 4 and 6. The ribbon is placed substantially on an intermediate panel placing fold lines adjacent to the edge of the ribbon (not covering); see figure 2 (prior art); as well as along opposed edge panels; figure 4.

Regarding claims 14-15, paperboard trim and/or cull is considered anticipated by Walsh as it is pre-cut.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claff (US 2,008,608) or Walsh (US 5,108,355) in view of Lang (US 5,147,480).

Neither Claff or Walsh disclose printing on the reinforcing strips however Lang discloses printing on reinforcing strips; see abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to include printing on the reinforcing strips in order to provide graphics/indicia according to a customer's needs.

10. Claims 26-28 and 30-33 (alternately) are rejected under 35 U.S.C. 103(a) as being unpatentable over Claff (US 2,008,608) in view of Walsh (US 5,108,355).

Claff does not directly disclose the use of paperboard (trim/cull) for the reinforcing strips, however Walsh does as noted supra. It would have been obvious to one of ordinary skill in the art at the time of the invention to include providing paperboard reinforcing material as taught by Walsh in the invention to Claff in order to provide added wall strength.

Regarding claims 30-33, the previous interpretation of "within" was interpreted broadly to mean within the formed carton. Walsh recognizes reinforcing layers fully within the panel boundaries defined by opposing fold lines; see figure 2. It would have been obvious to one of ordinary skill in the art at the time of the invention to include positioning reinforcing material as recognized by Walsh in the invention to Claff in order to form reinforced panels as desired.

### ***Response to Arguments***

11. Applicant's arguments filed 9/27/07 have been fully considered but they are not persuasive. Applicant is not entitled to the claimed limitations as governed by 35 USC 112.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3721

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

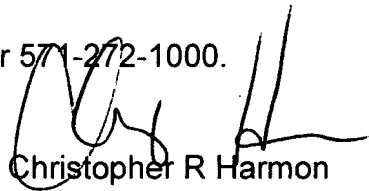
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher R Harmon  
Primary Examiner  
Art Unit 3721